



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Patent Cooperation Treaty Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

#7

09 MAR 1998

Karl Hormann, Esq.
86 Sparks Street
Cambridge, MA 02138-2216

In re Application of
GERHAEUSER et al
Application No.: 08/676,355
PCT No.: PCT/DE95/00055
Int. Filing Date: 16 January 1995
Priority Date: 19 January 1994
Attorney Docket No.: 960160
For: METHOD OF DETERMINING THE
RECEPTIVITY OF WIRELESS
SIGNALS IN A BROADCAST SYSTEM

DECISION ON PETITION

This is a decision on applicants' "Petition Pursuant to 37 C.F.R. 1.137(a)" filed in the Patent and Trademark Office (PTO) on 06 October 1997.

BACKGROUND

On 04 September 1996, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.63 was required.

On 05 May 1997, applicants filed a petition under 37 CFR 1.181 which was accompanied by a copy of a declaration of the inventors and a copy of a postcard receipt. The petition requested that the declaration be accepted as having been filed with the PTO on 20 August 1996.

On 23 September 1997, this Office mailed a decision dismissing the petition on the grounds that the postcard was not sufficient to establish that the declaration had been previously filed in the present application. The decision also set forth that the declaration of the inventors was not acceptable in that it did not properly identify the application to which it was directed.

On 06 October 1997, applicants filed the present petition which was accompanied by, inter alia, the requisite petition fee and a declaration of the inventors.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(a) must be filed promptly and be accompanied by: (1) an adequate verified showing of the cause of the unavoidable delay; (2) a proposed response; (3) the petition fee required by law (37 CFR 1.17(l)); and (4) a terminal disclaimer and fee (if required under 37 CFR 1.137(c)). Applicants' petition satisfies item (3).

With respect to item (1), applicants have failed to set forth a showing of any circumstances that would support a holding of unavoidable delay. Specifically, applicants have merely set forth that "the delay in prosecuting the application was unavoidable". However, applicants have not set forth how the failure to timely file a proper response to the Form PCT/DO/EO/905 was unavoidable.

With respect to item (2), a review of the application file reveals that the declaration filed with the present petition is unacceptable. Specifically, a review of the declaration reveals that it is an altered version of the previously submitted declaration. In this regard, section 602.01 of the Manual of Patent Examining Procedure (MPEP) states, in part:

The wording of an oath or declaration cannot be amended altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required.

Additionally, section 605.04(a) of the MPEP states, in part:

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant.

The declaration of the inventors is also not acceptable in that the last name of the first named inventor does not correspond to the name which is set forth in the international application. Additionally, a review of PTO records reveals that the surcharge for late filing of the declaration has not been submitted. In that a proper declaration of the inventors is being filed after the expiration of 30 months from the priority date, such a surcharge must be filed in order to constitute a proper response for revival of the application.

Finally, a review of the application file reveals that a terminal disclaimer and fee, as required under item (4) above, have not been filed.

Therefore, in that items (1), (2) and (4) have not been satisfied, the petition may not be properly granted.

CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.


If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)". No additional petition fee is required.

A proper response must include an acceptable showing of unavoidable delay, an acceptable declaration of the inventors, and the surcharge for late filing of the declaration.

Extensions of time may be obtained under 37 CFR 1.136(a).

In the alternative, applicant may wish to consider the filing of a petition to revive based on unintentional delay under 37 CFR 1.137(b).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Richard R. Cole
Legal Examiner
PCT Legal Office

(703)305-6639

RRC:rrc